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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/920,690

04/09/2003

Roger Biel

CL/V-30785A

5765

31781 7590 11/30/2005

CIBA VISION CORPORATION  
PATENT DEPARTMENT  
11460 JOHNS CREEK PARKWAY  
DULUTH, GA 30097-1556

EXAMINER

PUNNOOSE, ROY M

ART UNIT

PAPER NUMBER

2877

DATE MAILED: 11/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/920,690

Applicant(s)

BIEL ET AL.

Examiner

Roy M. Punnoose

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 22 is/are rejected.
- 7) ☒ Claim(s) 1 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Response to Remarks*

1. Receipt of applicant's amendments filed on September 16, 2005 is acknowledged.

**Applicant's arguments filed September 16, 2005 have been fully considered but they are not persuasive and has necessitated the Examiner to make this office action FINAL.**

2. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

3. Currently, claims 1-20 and 22 are pending in the application.

4. In the remarks section of the papers received on September 06, 2005 the applicant's basic argument with regard to claims 1-20 and 22 is that the Examiner has used hindsight reasoning in the application of prior-art documents Ross and Davis to reject said claims, and such use of hindsight is not permissible. The applicant further states that "... there is simply no suggestion to combine the system described in Ross with the camera in Davis. Hence, there cannot be a reasonable expectation of success. Accordingly, the named references cannot render the claims, as presently amended, obvious." The Examiner respectfully disagrees with the applicant because the applicant has not provided any details on why any particular element or limitation is unique to applicant's invention in the argument presented. Applicant merely states that the Examiner has used hindsight reasoning. Applicant's arguments filed September 16, 2005 are not convincing and the rejection of the previous office action is applicable to claims 1-20 and 22.

5. With regard to applicant's statement "...as presently amended, obvious", no amendments are present in the papers filed on September 16, 2005.

***Claim Objections***

6. Claim 1 is objected to because of the following informalities: the word “received” on line 2 is grammatically incorrect. The applicant may want to correct it to “receive”. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-20 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ross, III (US\_5719,669) in view of Davis, (US\_5,828,446).

9. Claims 1 and 7 are rejected because:

- A. Ross, III (Ross hereinafter) discloses an apparatus comprising a container 44 (see Figure 2), a monochromatic illuminating device 34 having a predetermined wavelength, a condenser lens 38 and a CCD camera (see col.2, lines35-38) for measuring various parameters (see abstract) of ophthalmic lenses so that quality of the lenses can be determined. However Ross does not teach the use of a high-resolution camera in an apparatus for measuring various parameters of contact lenses so that quality of said lenses can be determined.
- B. Davis discloses the use of a high resolution camera (see col.10, lines 28-32) in an apparatus for measuring various parameters of contact lenses so that quality of the lenses can be determined.

- C. In view of Davis' teaching, it would have been obvious to one of ordinary skill in the art to incorporate a high-resolution camera into Ross' apparatus due to the fact that such a combination would provide an apparatus that can more accurately measure optical parameters of contact lenses so that quality of said lenses can be determined.
10. Claims 2, 4 and 5 are rejected because In view of Ross' teaching of using IR wavelength range (see col.4, line 59) to measure optical parameters of lenses, it would have been obvious to one of ordinary skill in the art to select any particular wavelength in said range to measure optical parameters of lenses.
11. Claims 3 and 13 are rejected because Davis teaches the use of an LED (see col.4, line 61) in his apparatus.
12. Claims 6 and 14-17 are rejected because in view of Ross' teaching of the use of a filter (see col.8, line 59 - col.9, line 2) it would have been obvious to one of ordinary skill in the art to have any type of filter to be placed in front of the CCD camera to filter out unwanted wavelength(s) of light to more accurately measure the parameters of the contact lenses.
13. Claims 8-10, 18-20 are rejected because in view of Ross' teaching of placing the CCD camera in various azimuthal positions (see col.7, lines 27-34) it is obvious to one of ordinary skill in the art that x-y or x-y-z cradle is being used in Ross' apparatus.
14. Claim 11 is rejected because in view of Ross' teaching of the use of frame grabber and image processing algorithms/software (see col.7, lines 35-51), it is obvious to one of ordinary skill in the art that Ross' lens checking apparatus comprises a CCD camera that is linked to a computer, image taken by the CCD camera is stored in the computer and testing/analyzing is done by automatic image analysis software.

15. Claim 22 is rejected because Davis teaches the use of a transparent container to receive the contact lens (see Figure 7).

16. The arguments presented by the applicant are not convincing. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

17. A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Conclusion***

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Roy M. Punnoose** whose telephone number is **571-272-2427**. The examiner can normally be reached on 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gregory J. Toatley, Jr.** can be reached on **571-272-2800 ext.77**. The fax phone number for the organization where this application or proceeding is assigned is **571-273-8300**.

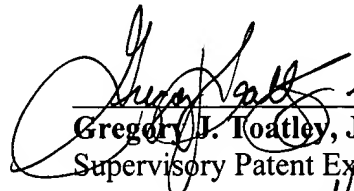
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

Art Unit: 2877

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**Roy M. Punnoose**  
Patent Examiner  
Art Unit 2877  
November 26, 2005



  
**Gregory J. Roatley, Jr.**  
Supervisory Patent Examiner  
28/Nov/05